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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,955	01/08/2002	Brent Anderson	113937-002	4496

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EXAMINER

PIAZZA CORCORAN, GLADYS JOSEFINA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/042,955

Applicant(s)

ANDERSON ET AL.

Examiner

Gladys J Piazza Corcoran

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 32-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 and 32-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>2/3/2004</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

FINAL ACTION

Information Disclosure Statement

1. As indicated in the prior Office action, the information disclosure statement filed August 26, 2003 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language (references FR 724974, CH 247934, FR 1074166, DE 1761403, DE 2332927). It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 9, 4, 14, 15, 27-29, 33, 48-50, 56, 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 2 recites the limitation "the first sheet" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --the first non-molten sheet--.

5. Claim 4 is unclear by reciting that the second polymeric material is a multiple layer structure while being dependent upon claim 3 which recites that the second polymeric material is a monolayer structure. It is suggested to amend the dependency

Art Unit: 1733

of claim 4 to claim 2. (As set forth in paragraph 4 of the prior Office action filed December 1, 2003).

6. Claim 9 recites the limitation "the second sheet" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --the second non-molten sheet--.

7. Claims 14 and 15 are unclear by reciting that the polymeric material is a second polyolefin, however there is never a first polyolefin. (As set forth in paragraph 5 of the prior Office action filed December 1, 2003).

8. Claim 27 recites the limitation "the first sheet" in line 13. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --the first non-molten sheet--.

9. Claim 28 recites the limitation "the second sheet" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --the second non-molten sheet--.

10. Claim 29 recites the limitation "the second sheet" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --the second non-molten sheet--.

11. Claim 33 recites the limitation "the first sheet" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --the first non-molten sheet--.

12. Claim 48 recites the limitation "the first sheet" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --the first non-molten sheet--.

13. Claim 49 recites the limitation "the first sheet" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --the first non-molten sheet--.

14. Claim 50 recites the limitation "the first sheet" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --the first non-molten sheet--.

15. Claim 56 recites the limitation "the second sheet" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --the second non-molten sheet--.

16. Claim 57 recites the limitation "the second sheet" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --the second non-molten sheet--.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 1-3, 9, 13, 16, 17-23, 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Karfiol et al. (US Patent No. 2,477,300).

Karfiol discloses a method for treating a surface of a layered polymeric structure by providing a first non-molten sheet of material (facing web 9), providing a second non-molten sheet of material (backing web 1), positioning the first non-molten sheet or the second non-molten sheet to overlap at least a portion of the other sheet to define an interference zone, directing a first molten polymeric material (plastic layer 7) into the interference zone to adhere the first non-molten sheet to the second non-molten sheet to form the layered structure and texturing an outer surface of the first non-molten sheet or the second non-molten sheet to form a pattern on the outer surface (column 2, lines 20-38).

As to claims 2, the first sheet (facing web 9) is a second polymeric material. As to claim 3, the second polymeric material is a monolayer structure. As to claim 9, the second sheet is a third polymeric material or paper (backing web 1). As to claim 13, the step of directing a first polymeric material comprises the step of extruding a molten polymeric material (column 2, lines 9-13). As to claim 16, the step of texturing is carried out essentially immediately after the step of adhering the first sheet to the second sheet. As to claim 17, the step of texturing comprises the step of contacting the first or second sheet with a surface having a pattern (rolls 11 and 4). As to claim 18, the surface is provided on a roll. As to claim 20, the roll is a back-up roll. As to claim 21, the pattern is carried on two rolls (rolls 4 and 11). As to claims 22 and 23 the pattern extends outward and inward from the surface of the roll (column 3, lines 35-48). As to claim 26, the pattern comprises a plurality of spaced objects. As to claim 26, the pattern comprises a plurality of spaced objects (grooves).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

21. Claims 4, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karfiol et al. (US Patent No. 2,477,300), as applied to claims 3 and 18 above, and further in view of conventional practice.

The reference Karfiol does not specifically disclose the particular materials the embossing rolls are formed of, however it is well known and considered conventional in the art to form embossing rolls of metal, rubber, cork or plastic. It would have been obvious to one of ordinary skill in the art at the time of the invention to form the materials as shown by Aizawa or DellaVecchia with embossing rolls formed of conventional materials as is well known in the art and well within the purview of one of

Art Unit: 1733

ordinary skill in the art. It is noted that Applicant has not traversed this statement, therefore it is considered acquiesced by Applicant as admitted prior art.

As to claim 4, it is well known in the art to provide base layers for decorative materials out of multiple layers. It would have been well within the purview of one of ordinary skill in the art to provide the base layer in Karfiol of a multiple layer structure as considered well known in the art. Only the expected results would be attained.

22. Claims 5-12, 14-16, 27-30, 32-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karfiol et al. (US Patent No. 2,477,300) in view of conventional practices as exemplified by Aizawa (US Patent No. 5,928,762).

As to claims 5-8, 10-12, 14, 15, 27, 29 Karfiol does not disclose the particular polymeric material used for the layers, only suggesting that any known thermoplastic or thermosetting material may be used. It is well known in the art to provide the claimed polymeric material for film layers in decorative materials. Additionally, Aizawa discloses a decorative material formed of the claimed materials (column 2, lines 54-65; column 5, line 42 to column 6, line 5). As to claim 6, the polyolefins in Aizawa are selected from homopolymers and copolymers. As to claim 7, Aizawa discloses wherein the copolymers are selected from copolymers of ethylene and α -olefins having from 3 to 20 carbons (column 2, lines 54-65). As to claim 8, it would have been obvious to provide the decorative sheet of multiple layers of the well known materials as further exemplified by Aizawa, only the expected results would be attained. It is noted that Applicant has not asserted any criticality to the particular layer and these combinations are known in the art. As to claim 14, Aizawa discloses the molten polymeric material is a second

Art Unit: 1733

polyolefin (column 12, lines 25-30). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the polymeric layers in Karfiol with well known conventional materials for decorative material laminates as exemplified by Aizawa, only the expected results would be attained.

As to claim 32, the polymeric material 7 in Karfiol is considered to be an adhesive material.

As to claims 9 and 28, Karfiol discloses the base layer can be of a paper or plastic or other opaque material. It is well known in the art to provide bases for decorative materials out of metal. For example in Aizawa, the second sheet is selected from the group consisting of a third polymeric material, paper, and metal (column 5, lines 30-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the base material in the method as shown by Karfiol with conventional materials such as metal, as exemplified by Aizawa. Only the expected results would be attained.

As to claims 16 and 30, Karfiol discloses a method of embossing decorative material where the embossing step appears to be carried out immediately after the laminating step. However, it is well known in the art to provide embossing to packaging materials by either embossing prior to laminating or simultaneously embossing the material and laminating the material in order to reduce excess steps and conserve heating. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming the packaging material as shown by Karfiol

by simultaneously carrying out the embossing and laminating steps as is known in the art and exemplified by Aizawa in order to reduce steps and conserve heating.

As to claim 33, the step of texturing comprises the step of contacting the first or second sheet with a surface having a pattern (rolls 11 and 4). As to claim 34, the surface is provided on a roll. As to claim 36, the roll is a back-up roll. As to claim 37, the pattern is carried on two rolls (rolls 4 and 11). As to claims 38 and 39 the pattern extends outward and inward from the surface of the roll (column 3, lines 35-48). As to claim 40-47, it would have been well within the purview of one of ordinary skill in the art at the time of the invention to provide a variety of decorative designs on the decorative material, only the expected results would have been attained. As to claims 48, 49, the first sheet in Karfiol is a monolayer. As to claim 48 and 50, it is well known in the art to provide base layers for decorative materials out of multiple layers. It would have been well within the purview of one of ordinary skill in the art to provide the base layer in Karfiol of a multiple layer structure as considered well known in the art. Only the expected results would be attained. As to claims 51-60, it would have been obvious to provide the decorative sheet of multiple layers of the well known materials as further exemplified by Aizawa, only the expected results would be attained. It is noted that Applicant has not asserted any criticality to the particular layer and these combinations are known in the art.

Response to Arguments

23. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys J Piazza Corcoran whose telephone number is (571) 272-1214. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone

Art Unit: 1733

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gladys J. Corcoran
Examiner
Art Unit 1733

GJPC